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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,685	07/25/2001	Michael A. Epstein	US010339	6976

24737 7590 09/02/2004

PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
P.O. BOX 3001  
BRIARCLIFF MANOR, NY 10510

EXAMINER
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MAI, TAN V

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/912,685

**Applicant(s)**

EPSTEIN, MICHAEL A.

**Examiner**

Tan V Mai

**Art Unit**

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892) \*
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/25/01 & 10/3/02.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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1. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per independent claim 1, the phrase "using a marking signal" (lines 3-4) is NOT understood. Similarly noted claim 24. The "decorrelating" step seems to be redundant because the other step(s) do NOT use the result of "decorrelating" step. Similarly noted claim 16 and claims 24 & 30 "linear feedback shift register".

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-4, 6-19, 21-28 and 30-32 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-18 & 32-34 of U.S. Patent No. 6,631,390 in view of Weiss.

The independent claims 1, 16, 24 & 30 recite the same features as independent claims 10, 17-18 & 32-34 of U.S. Patent No. 6,631,390 of and further comprising "decorrelating" step or "linear feedback shift register". The feature is old

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and well known in the art. For example, Weiss discloses a method and system for providing a random number generator having the claimed feature, e.g., see col. 4, lines 19-40; discuss about meta-stable condition and col. 6, lines 14-56; discuss about the "linear feedback register". It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Weiss feature in independent claims 10, 17-18 & 32-34 of U.S. Patent No. 6,631,390 Rault, thereby making the claimed invention, because the proposed device is a random number generator having a "linear feedback register" feature for "decorrelating" the marking signal as claimed.

As per dependent claims 2-4, 6, 17-19, 21, 27-28 and 31-32, the claims detail the structure and function of the "linear feedback register". Weiss does the claimed features.

As per dependent claims 7-16 and 22-26, the claims features are nearly identical to the dependent claims 11-16 of U.S. Patent No. 6,631,390.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6-8, 12-14, 16-19, 24-26 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Quere in view of Weiss.

As per independent claim 1, Le Quere discloses, e.g., see Figs. 2-5, the invention substantially as claimed, including: a logic circuit (10) [is arranged to deliver at an output a signal in an intermediate qualified as **metastable** between "0" and "1" and being constituted by a random number sequence] and pseudo random number generator (6). It is noted that Le Quere does NOT specifically detail the claimed "decorrelating" step; however, the feature is old and well known in the art. For example, Weiss discloses a method and system for providing a random number generator having the claimed feature, e.g., see col. 4, lines 19-40; discuss about meta-stable condition and col. 6, lines 14-56; discuss about the "linear feedback register". It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Weiss feature in Le Quere, thereby making the claimed invention, because the proposed device is a random number generator having a "linear feedback register" feature for "decorrelating" the marking signal as claimed.

As per dependent claims 2-4 and 6, the claims detail the structure and function of the "linear feedback register". Weiss does the claimed features.

As per dependent claims 7-8, Le Quere discloses the claimed features, e.g., see Fig. 4c, col. 4, line 60 to col. 5, line 19.

As per dependent claim 12, Le Quere discloses the claimed features, e.g., see abstract, "[a]n internal memory stores the random numbers obtained as output signals from the pseudo-random generator".

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As per dependent claims 13-14, the features are obvious to one of ordinary skill in the art.

Due to the similarity of method claims 16-19 and 21-23 to method claims 1-4 and 6-8, and 12, they are rejected under a similar rationale.

Due to the similarity of apparatus claims 24-29, 30-32 to method claims 1-4 and 6-8, and 12-14, they are rejected under a similar rationale.

6. Claims 5, 20, 29 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cited reference is art of interest.

8. The following is an examiner's statement of reasons for allowance: the recorded references do NOT teach or suggest the "compensation circuit" feature as recited in dependent claims 5, 20, 29 and 33.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan V. Mai whose telephone number is (703) 305-9761. The examiner can normally be reached on Tue-Fri from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (703) 305-9662. The fax phone numbers for the organization where this application or proceeding is assigned are:

Official (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



TAN V. MAI  
PRIMARY EXAMINER